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Supreme Court of the United States

OCTOBER TERM 1941

No. 661, 705, 740

AMERICAN TRI-ERGON CORPORATION and TRI-ERGON HOLDING A. G.,

Petitioners (Plaintiffs),

v.

RADTKE PATENTS CORPORATION and ALBERT A. RADTKE, WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON, CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondents (Defendants).

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA, AND BRIEF FOR PETITIONERS IN SUPPORT THEREOF

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Dated, September 25, 1941

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Respondents (Defendants),

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

TO THE HONORABLE THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The petitioners above named respectfully pray for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia to review the judgment of that Court in the above entitled cause. A transcript of the record therein including the proceedings in said Court of Appeals is furnished herewith in accordance with the Rules of this Court.

Short Statement of Matter Involved

1. Jurisdiction

This Court's jurisdiction is invoked under Section 240 (a) of the Judicial Code (28 U. S. C. A. 347). The date of the judgment of which petitioners seek review is June 30, 1941 (III R. 2081), rehearing denied August 29, 1941 (III R. 2094).

2. Nature of Suit

The suit was filed by petitioners in the District Court of the United States for the District of Columbia under Rev. Stat. 4915 (35 U. S. C. A. 63) with prayer for a decree authorizing the grant of a patent upon a patent application held by them. The issues arose out of prior interference proceedings involving this application and conflicting applications of respondents Radtke and Whitson, and decided in Radtke's favor in the Patent Office. In the opinions below petitioners are frequently referred to collectively as "Vogt", and the above respondents as "Whitson" and "Radtke".

3. Subject Matter Involved

The three conflicting patent applications deal with the electrical reproduction of sound (e. g. speech or music) so as to correspond with sound previously produced, and utilized to produce "acoustically modulated light" which reacts upon the other elements of the combinations specified in the claims in controversy, to reproduce the original sound. The general subject matter is succinctly described in the Findings of Fact of two District Judges (II R. 1635; and 1521, No. 11). The four claims in controversy are set forth at II R. 1634. These claims set forth a sound reproducing apparatus wherein a photoelectric cell having an alkali cathode is associated (1) with means for subjecting the cell to "acoustically modulated light" (e. g. a photo-

graphic film having areas of varying degrees of blackness proportional to successive sounds to be reproduced); and (2) with a circuit in which flows a correspondingly modulated current, i. e. one which varies proportionally to the intensity of the light affecting the photoelectric cell. Claims 3 and 4 also specify an amplifier circuit as associated with the photoelectric cell and its immediate circuit above referred to.

Related subject matter was considered on the basis of its general importance by this Court in *Altoona Publix Theatres Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477. A film feeding machine as shown in petitioners' Patent No. 1,713,726 involved in the prior Altoona suit has been generally used in recent years in the motion picture industry for feeding photographic films past a photo-electric cell to supply the "acoustically modulated" light element of the combinations here involved. The present subject matter is accordingly of equal importance.

4. Prior Proceedings

The important events as outlined in the majority opinion of the Court of Appeals (III R. 2056) are:

(1) Initial rejection of the claims by the Patent Office (II R. 1619).

(2) A suit filed by petitioners under Rev. Stat. 4915 against the Commissioner of Patents (not the present suit) in the District Court of the District of Columbia, in which after trial and argument a final decree was entered authorizing the grant of a patent thereon to petitioners (III R. 1625) upon an opinion by Justice Adkins of that Court (II R. 1646-50) and his accompanying Findings and Conclusions (II R. 1633-46); in this decree the Commissioner acquiesced since he took no appeal.

(3) The action of the Commissioner of Patents in declaring interference proceedings to adjudicate priority between the applications of Whitson, Radtke and petitioners (II R. 1626), instead of proceeding to issue a patent to petitioners in accordance with such decree.

(4) Patent Office Interference decisions awarding priority of invention to Radtke, not on the ground that Radtke established any effective date of invention prior to petitioners (see particularly III R. 1973) but on finding petitioners' original application disclosure insufficient in that certain "inventive features" undisclosed therein would also have to be used to enable one skilled in the art to practice the invention (see III R. 1998; also I R. 30 to the effect that "considerable experimentation and invention" would be needed to make petitioners' disclosure operate). Thus the Commissioner took it upon himself, through his interference tribunals, to differ with the District Court as to the adequacy of petitioners' application disclosure, and on that ground authorized the grant of a patent to Radtke instead of petitioners.

(5) The action of the Commissioner in issuing a patent on Radtke's application (III R. 1798) shortly prior to this suit.

5. The Present Suit

Thereupon petitioners filed the present suit in the United States District Court for the District of Columbia, again praying for a decree authorizing the grant to them of a patent containing the same four claims which the same Court had previously authorized, and joining as defendants the Commissioner of Patents and the Radtke and Whitson parties who had been their opponents in the interference proceedings (I R. 2).

In their Answers none of the parties defendant denied petitioners' allegations as to the patentability of the claims, nor pled any facts upon which such a defense might have been predicated. The Commissioner admitted that he had refused to issue a patent to petitioners "in view of the decision of the Board of Appeals in said interference" and denied petitioners' allegations as to the incorrectness of such decision (I R. 19). Radtke and Whitson each pled that he was the *inventor* of the subject matter (I R. 25, 44).

(a) *The District Court's Decision Herein*

After a trial and argument in the District Court Justice Goldsborough of that Court filed an Opinion (II R. 1510-18) and Findings and Conclusions (II R. 1518-25). He held (contrary to the Patent Office Interference ruling, but in accord with Justice Adkins *supra,* p. 4) that petitioners' application disclosure was sufficient, and agreed with the Patent Office that neither Radtke nor Whitson had established a prior date of invention. He further held that while the prior decision of the same Court in petitioners' favor was not binding on him, he would follow it in the absence of clear error or additional evidence which might have induced a different decision, and that

> "the Court finds neither the error nor the evidence" (II R. 1517).

Accordingly a final decree was entered in the District Court to the effect that the claims are patentable and that petitioners are entitled to a patent containing them (II R. 1526).

(b) *The Majority Court of Appeals Decision Herein*

Appeal by Radtke and Whitson resulted in a split decision. As regards the relative rights of petitioners and Radtke, the majority opinion quotes crucial Findings of the District Court as to the sufficiency of petitioners' application disclosure (III R. 2076) and states "In our view these findings are supported by the evidence and prove that Radtke invented nothing" (III R. 2077), thus concurring with the District Court that the basis of the Patent Office interference decision in Radtke's favor (*supra,* p. 4) was unsound.

Then the majority went on to state "However we do not reach the conclusion therefrom that Vogt invented anything either" (III R. 2077) and directed dismissal of petitioners' complaint on a holding that the subject matter is lacking in invention over the prior art.

But as shown by the dissenting opinion (see *infra*, p. 8), the proceedings in this suit had not raised this issue of non-patentability.

The majority finding of lack of invention is founded primarily on two propositions (1) it harps back to the *initial* rejection of the claims by the Patent Office (*supra*, p. 3) as a basis for holding "the judicial function is exhausted when there is found to be a rational basis for the conclusions approved by the administrative body" and that "if there was a rational basis for that decision, it should be sustained" (III R. 2059); and (2) it finds (as a conclusion of scientific fact) that from the standpoint of an expert scientist having full knowledge of the prior art, no inventive genius was involved in the subject matter in suit.

As to the first proposition, the majority opinion does not explain why the Court seized upon an initial ruling for the above purposes, ignoring the subsequent and final rulings of the Patent Office (items 3 to 5 listed *supra*, pp. 3, 4) all three of which are predicated upon departmental rulings that the subject matter constitutes invention.

In support of the second proposition, the majority constitute themselves their own scientific experts on the significance to one skilled in the art of the numerous scientific documents which they cite. As shown by the note appended to the minority opinion (III R. 2079) *many of these treatises were not in evidence,* and to the list in that category should be added the Langmuir and Wold patents and the Kunz article cited in the majority opinion at III R. 2070. A number of these publications were *long subsequent in date* to petitioners' application (see note in dissenting opinion at III R. 2079).

Neither the Patent Office nor either of the District Judges ever made a finding that any of these treatises render the subject matter unpatentable, and in so far as such treatises were in the record the findings of both District Judges and actions of the Patent Office in the interference and in issuing Radtke's patent, must be taken as to the contrary (*supra*, pp. 4, 5).

Nor do we find any place in the record where any witness testified that these treatises disclosed to one skilled in the art enough to enable him to evolve the subject matter in suit by the exercise of ordinary skill and knowledge in the art. Neither by the pleadings (*supra,* p. 4) nor by the testimony were petitioners apprised of the contentions of unpatentability advanced in the majority opinion, or of any need of rebuttal evidence thereon. On the basis of the interference evidence, the Commissioner through his interference decisions saw fit to rule differently from Justice Adkins on the sufficiency of petitioners' application disclosure and adhered to that position in this suit (*supra,* p. 4), but he took no such action as to patentability.

The majority finding of unpatentability is also referred to "contentions" or positions taken in argument by counsel opposing petitioners (III R. bottom of pp. 2065, 2067, 2071, 2072, 2077) and to alleged "repudiation" by petitioners and their opponents of certain findings of Justice Adkins (III R. 2071, 2073).

There was also the suggestion as to certain features of the claimed combinations that petitioners are somehow prejudiced because they did not originally "claim" them to be invention, not that petitioners failed to insert patent claims on these features, but in the sense that there was no original *assertion* that these features required invention (see III R. 2064 as to "extravagant claims", 2067 as to Vogt's "theory of invention", 2072). The Court also took petitioners' statements that amplifiers and their circuits were well known, to be admissions of lack of invention in the *immediate photoelectric cell circuit,* which as later discussed is an entirely different and distinct thing (III R. 2070, 2071, 2072).

On the basis of the above matters the majority opinion attacks six out of thirty-five fact findings of Justice Adkins (II R. 1633-46) in support of patentability, and without any discussion of the weight or significance of the other twenty-nine findings which he made.

(c) *The Dissenting Court of Appeals' Opinion*

The minority opinion points out that the proceedings had not raised the issues passed upon by the majority (III R. 2078), found the majority decision to be an "unwarranted collateral attack" upon Justice Adkins' decision, that the question of patentability is "at least debatable, and * * * ought not, in my opinion, in fairness to the parties, be decided for the first time on appeal"; stating that "scientific references which are not in the record", should not be considered nor judicial notice taken of a disputed fact (III R. 2079), concluding—

> "I think an appellate court cannot properly reach an answer to such a question upon the basis of its own examination of data not in the record, and which may be disputable, without first affording opportunity to the parties to be heard in respect to it and an opportunity to supply additional relevant data" (III R. 2080).

Thus since the decree of Justice Adkins in 1931 endorsing petitioners' right to a patent, petitioners have been subjected to the following time-consuming, expensive and vacillating proceedings: Instead of granting the patent the Commissioner instituted the interference proceedings to determine the question of priority of invention as between Whitson, Radtke and petitioners; then came the Commissioners' interference decisions in which he ruled that neither Whitson nor Radtke had established any prior effective date, but proceeded to differ with Justice Adkins as to the sufficiency of petitioners' application disclosure and awarded and issued a patent to Radtke on that ground; then the decision of Justice Goldsborough agreeing with the Patent Office that Radtke and Whitson had established no prior effective date, agreeing with Justice Adkins and the Patent Office that the subject matter is patentable, and disagreeing with the Patent Office but agreeing with Justice Adkins that petitioners' application disclosure is adequate; then

the majority appellate opinion agreeing with Justice Adkins and Justice Goldsborough that petitioners' application disclosure is sufficient, agreeing with both District Judges and the Patent Office as to petitioners' priority over Radtke, but holding on the basis of its own researches contrary to both District Judges and the *final* rulings of the Patent office, and in the face of Radtke's issued patent, that the subject matter lacks invention; and accompanied by a dissenting opinion to the effect that the majority appellate holding of lack of invention is without justifiable grounds.

Thus as to patentability, three of the tribunals have held with petitioners, two of the appellate judges have held to the contrary, but the third appellate judge has held the views of the other two to be unjustified.

And Radtke stands with an issued patent despite concurrence by the majority of the appellate court in the District Court's finding that the disclosure of petitioners' application is adequate and proves "that Radtke invented nothing" (III R. 2077). Radtke is thus left free to contest the validity of his patent elsewhere under circumstances where as discussed later (p. 24), the Court of Appeals' decision, if it stands, will eliminate petitioners' priority (concurred in by the appellate court) as a ground of invalidity of the Radtke patented claims. At I R. 208 it was alleged in Radtke's behalf that the large interests engaged in exploiting sound motion picture apparatus are paying royalties and operating under licenses predicated on this patent, and Shepherds' Citations shows nine suits filed under such patent against smaller (and presumably unlicensed) operators in the New York area.

Thus despite its stress on the "public" interest (III R. 2059) the majority opinion unjustly sets up the Radtke interests.

Questions Presented

1. Was there a justifiable basis for the Appellate Court's finding of lack of invention in the technical subject matter here involved, under circumstances where—

   (a) The finding is predicated upon the Court's own appraisal of scientific treatises many of which were not in evidence and some later in date than petitioners.

   (b) Petitioners were not apprised of such a defense by the pleadings, nor was the finding supported by testimony of witnesses skilled in the art asserting that the subject matter was thereby rendered obvious.

   (c) There were no findings by either of the trial judges or by the Patent Office ascribing to these treatises the significance found by the appellate court.

   (d) The finding of the Appellate Court in so far as it involves matters passed upon by the District Court, is contrary to the findings of two District Judges, and contrary to the *final* rulings of the Commissioner of Patents on the subject matter.

2. On the record as it came before the Court of Appeals and on concurrence by that Court in petitioners' priority over Radtke's already issued patent, should not the decree of the District Court have been affirmed?

3. Or if (contrary to petitioners' position) the Appellate Court was justified in raising *de novo* the intricate matters of scientific fact and opinion discussed in the majority opinion, should not the case have been remanded to the District Court for evidence and findings on these matters in order to accord petitioners a fair hearing and their day in court in respect thereto?

Reasons Relied on for Allowance of the Writ

1. In holding the subject matter unpatentable on the basis of its own researches on technical documents (some not in evidence and others later than petitioners) and without expert testimony or findings of the trial court or the Commissioner of Patents supporting its conclusions in respect to such documents, the Court of Appeals has so departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision (this Court's Rule 38, 5 (b); dissenting opinion III R. 2080; *Helis* v. *Ward,* 308 U. S. 365, 370).

2. The Court of Appeals has decided the merits against petitioners on matters of scientific fact and opinion as set forth in its opinion, as to which petitioners have not had fair opportunity for cross examination or the presentation of rebutting evidence, and have therefore been denied their day in Court (*Helis* v. *Ward,* 308 U. S. 365, 370).

3. In reversing, without supporting testimony of those skilled in the art, the *final* rulings of the Commissioner of Patents and the concurring rulings of two District Judges that the subject matter is patentable, the Court of Appeals did not give proper effect to applicable decisions of this Court (*Morgan* v. *Daniels,* 153 U. S. 120, 125; *Mississippi Valley Barge Line Co.* v. *United States,* 292 U. S. 282, 286, 287; *Adamson* v. *Gilliland,* 242 U. S. 350, 353), also Rule of Civil Procedure No. 52(a); this Court's Rule 38, 5 (b) (c)).

4. The United States Court of Appeals for the District of Columbia has decided a question of general importance which should be reviewed by this Court. (This Court's Rule 38, 5 (c); *Altoona Publix Theatre Inc.* v. *American Tri-Ergon Corp.,* 294 U. S. 477, and *supra,* page 3.)

5. The decision of the Court of Appeals if permitted to become final will unjustly relieve Radtke's already issued patent from the consequences of petitioners' adjudi-

cated priority over Radtke, so that this defense against the Radtke patent could not later be presented to this Court or any other court in any other case (*Schriber-Schroth Co.* v. *Cleveland Trust Co., et al.,* 305 U. S. 47).

6. The action of the Court of Appeals in holding that petitioners' successful pioneership in sound-on-film reproduction is shown to be non-inventive on the basis of "numerous * * * experimenting and writing" (III R. 2077) which never achieved success, is contrary to applicable decisions of this Court (this Court's Rule 38, 5 (c); *Smith* v. *Snow,* 294 U. S. 1, 6; *The Barbed Wire Patent Case,* 143 U. S. 275, 283; *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45).

7. In holding that its "capacity as guardian of the public interest" justified the consideration of *de novo* grounds of lack of invention on intricate and technical subject matter, which grounds neither the Commissioner of Patents nor the other defendants undertook to prove or try out in this cause, and in the face of Radtke's already issued patent, the Court of Appeals erroneously expanded and applied this Court's decision in *Hill* v. *Wooster,* 132 U. S. 693. (This Court's Rule 38, 5 (c).)

WHEREFORE, your petitioners pray that a writ of certiorari be issued under the seal of this Court, directed to the United States Court of Appeals for the District of Columbia, to the end that this cause may be reviewed and determined by this Court; that the decree of said Court be reversed and the decree of the United States District Court for the District of Columbia be affirmed; and that petitioners be granted such other and further relief as may be found just and proper.

KENNETH S. NEAL,
PAGE S. HASELTON,
Counsel for Petitioners.

Dated, New York, September 25, 1941.

Supreme Court of the United States

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Respondents (Defendants).

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I

Opinions below.

The opinion of the District Court is reported at 30 Fed. Supp. 83. At this writing the opinion of the Circuit Court of Appeals has not been officially reported.

II

Grounds of jurisdiction and statement of case.

The above matters are believed to be sufficiently set forth in the foregoing Petition.

III

Assignment of errors.

Petitioners urge that the United States Court of Appeals for the District of Columbia erred:

1. In reversing the decree of the District Court and directing dismissal of petitioners' complaint.

2. In finding lack of invention in the technical subject here involved, on the basis of the Court's own appraisal of scientific treatises, many of which were not in evidence and some later in date than petitioners, and without testimony of those skilled in the art or findings of the trial court or of the Patent Office, supporting the Court's view that these treatises rendered the whole matter obvious.

3. In holding the subject matter to be unpatentable in the face of the findings of two District Judges and the *final* rulings of the Commissioner of Patents to the contrary.

4. In adopting an *initial* ruling of the Commissioner of Patents as a basis of applying the rule that "if there was a rational basis for that decision it should be sustained," under circumstances where all the later and *final* rulings of the Commissioner were to the contrary.

5. In holding the subject matter to be unpatentable on the basis of matters outside of the pleadings and proofs, and as to which petitioners have had no fair opportunity to be heard.

6. In according evidential weight on the question of patentability, to "contentions" or "positions" taken in argument by counsel opposing petitioners.

7. In finding any "repudiation" by petitioners of any of the findings of the District Court.

8. In finding features of the claimed combinations to be unpatentable because petitioners' original application did not proclaim them to be of inventive character.

9. In treating statements made by petitioners in respect to amplifiers and their circuits, as admissions of lack of invention in petitioners' immediate photoelectric cell circuit.

10. In holding experimenting and writings by others which never achieved any success to be evidence of lack of invention.

IV

Argument.

POINT 1

Petitioners were not previously confronted with the contentions advanced in the majority appellate opinion as to lack of invention, and had no fair hearing thereon.

As ground for dismissing petitioners' complaint, the majority appellate opinion boils down to a hypothetical finding that one skilled in the art, with knowledge of the scientific treatises cited and exercising only ordinary skill of the calling, would have conceived that successful sound reproduction could be achieved by the claimed combination of elements, and would have been able to assemble the combina-

tion and make it work successfully. No finding short of this would have been of legal significance since as held in *Seymour* v. *Osborne,* 11 Wall 516, 555:

> "Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation."

The pleadings supported no such defense. The Commissioner's Answer on the contrary asserted the correctness of the interference decision of his Board of Appeals, to the effect that even with a knowledge of petitioners' application disclosure "considerable additional experimentation and invention" would be needed to make this disclosure operative (*supra,* p. 4). Radtke and Whitson each pled that he was the *inventor* thereof (*supra,* p. 4).

We have likewise searched the record in vain for testimony of any witness to the effect that these scientific treatises either singly or collectively would enable one skilled in the art to conceive and put into practice the claimed combinations. Neither the Commissioner nor the other defendants undertook at the trial to establish by testimony what the Appellate Court has now found. If some witness had undertaken to assert the proposition and explain wherein the things which the publications did disclose would be sufficient to make the subject matter obvious to one skilled in the art, and wherein the things not disclosed would have been no obstacles, then petitioners might have been put on notice to cross examine and present rebuttal evidence on the points raised, but nothing of that sort occurred at the trial.

Consequently there was no occasion or opportunity for petitioners to cross examine on these matters which the majority opinion itself refers to as "intricate and technical questions" (III R. 2059), nor occasion nor opportunity for petitioners to present rebuttal evidence thereon.

On the argument in the Court of Appeals, motion was made that a brief submitted amicus curiae against patentability be received. It was then stated in open court from the Bench that if the brief should be considered, opportunity would be accorded the litigants to answer it, but the decision was rendered without such opportunity.

At III R. 2060 the majority opinion quotes statements from an initial Patent Office decision back in 1927 about certain Fritts and British patents, over which Justice Adkins held petitioners entitled to a patent (II R. 1640). These patents were neither pled nor included in the present record, nor any evidence presented in regard to them. We submit that it was not incumbent upon petitioners as part of their *prima facie* case to resurrect previously discarded patents or publications on which neither the Commissioner nor any of the other defendants saw fit to introduce evidence in the present suit, and which were not the grounds of any *final* action by the Patent Office.

Although the majority opinion says that the above initial Patent Office rule states the "reasons which, in our opinion, support the conclusion that there was no invention" (III R. 2060) the reasons the Court goes on to give for its holding (III R. 2061-78) are in nowise founded on the above Fritts and British patents, but upon other scientific treatises on which the above initial Patent Office decision made no findings (II R. 1619).

In short, neither by the pleadings nor the proofs, were petitioners apprised of any issue as to matters of technical fact and opinion such as the majority opinion saw fit to raise and determine, nor was evidence presented thereon.

> "In such a case, the question is whether the difference or differences between the subject claimed in the pat-

> ent in suit and the prior art, amount to invention; and it is generally necessary for a defendant to introduce expert testimony on that point (Waterman v. Shipman, 55 Fed. 982, 987, C. C. A. 2 [1893], for a question of invention is a question of fact)" (citing authorities) (*Walker on Patents,* Deller's Ed. Vol. 3, p. 2025).

The subject matter here involved plainly is not so simple as to justify departure from the general rule.

> "The flow or flux of electric or magnetic currents, the reactions of bodies into some chemical union or disunion, are matters in which a court must perforce depend upon the assertions of some one who has made a profound study of the matter" (*Sundh Elec. Co.* v. *General Elec. Co.* [2 Cir.], 204 Fed. Rep. 277, 279).

We submit that the dissenting appellate opinion speaks eloquently on the above points in stating that the majority's finding is at least debatable and ought not in fairness to be decided for the first time on appeal; that an appellate court should not take judicial notice of disputable facts or

> "reach an answer to such a question upon the basis of its own examination of data not in the record, * * * without first affording opportunity to the parties to be heard in respect of it and an opportunity to supply additional relevant data" (III R. 2080).

As in *Helis* v. *Ward,* 308 U. S. 365, certiorari is here sought on the ground that the Court of Appeals has

> "decided the merits on facts not contained in the record and on a theory which had never been tried by the litigants" (308 U. S. 370).

POINT 2

The appellate finding of lack of invention is predicated upon a legal principle which points directly to the opposite conclusion.

We have referred *supra,* page 6 to the fact that the majority opinion adopts the *initial* ruling of unpatentability by the Commissioner as a basis for applying the principle that the "judicial function is exhausted when there is found to be a rational basis for the conclusions approved by the administrative body" (III R. 2059), citing *Mississippi Valley Barge Line Co.* v. *United States,* 292 U. S. 282, 286, 287. A similar rule was announced in *Morgan* v. *Daniels,* 153 U. S. 120, 125 as to final rulings of the Patent Office.

But in the present case all of the *later* and *final* actions and rulings of the Commissioner referred to *supra,* pages 3, 4, were to the effect that the subject matter involves invention and is patentable. According to Rule 93 of the Patent Office Rules of Practice, interference proceedings are declared

> "between two or more parties claiming substantially the same patentable invention, and may be instituted as soon as it is determined that common patentable subject matter is claimed."

Thus the declaration of the interference (*supra,* p. 3, item [3]) necessarily involved a finding of patentable subject matter and invention. Likewise the Patent Office award of priority of *invention* (III R. 1998) was also a ruling of patentability. The Patent Office interference rulings that even with a knowledge of petitioners' application disclosure, additional "inventive features" would have to be used in practicing the invention (*supra,* p. 4, item [4]) were in the extremist sense reversals of the initial ruling adopted by the majority of the Appellate Court. As noted *supra,* page 4, the Commissioner's Answer in the present suit denied

that the interference rulings were incorrect, but did not assert the subject matter to be lacking in invention. The action of the Commissioner in issuing Radtke's patent (*supra,* p. 4, item [5]) was also a later ruling of patentability of the most final character.

Thus the very legal principle upon which the majority Appellate opinion is founded, points to a finding directly opposite to the one made.

POINT 3

The majority appellate finding of lack of invention is without justifiable basis.

We have referred *supra,* pages 17, 18 to the legal principle that supporting testimony of those skilled in the art is required as a foundation for such a finding on "intricate and technical questions" (majority opinion III R. 2059) as here involved, and to the absence of such testimony in the present evidence.

The *final* rulings of patentability by the Commissioner, as already discussed, are another reason why the action of the Appellate Court was unjustified. And in so far as the scientific documents cited by the Appellate Court were in the record and before either of the District Judges, their concurrent finding of patentability are supported by the rule that "so far as there is any testimony consistent with the finding, it must be treated as unassailable" (*Adamson* v. *Gilliland,* 242 U. S. 350, 353). Perusal of Justice Adkins' findings (II R. 1633-46) will show many of them with which the majority Appellate decision in nowise undertakes to disagree, and which are consistent with the finding of invention.

At III R. 2063 the majority opinion undertakes to criticise a part only of Justice Adkins' Finding No. 7 (II R. 1636) but, as we submit, without showing any error therein. Justice Adkins' Finding No. 10 is criticised at III R. 2064 and

Finding No. 15 at III R. 2072, on the ground that petitioners originally advanced no such "claims". We are aware of neither reason nor authority depriving a man of the benefit of proven facts on any such ground. No applicant is required to include in his application allegations to the effect that he was "the first to investigate and demonstrate that photoelectric cells possessed such characteristics as to meet each of "the peculiar requirements of sound reproduction" (III R. 2064), nor allegations to the effect that he was "the first to devise suitable connections between the photoelectric cell, etc." (III R. 2072), in order to preserve his rights to such features of novelty therein as may appear by the actual facts. When petitioners first had opportunity to present evidence they proved the above facts as Justice Adkins found, and nothing cited by the Court of Appeals amounts to evidence demonstrating that Justice Adkins was incorrect. The allegation that petitioners had not previously "claimed" to have done this or that, is consistently adopted in the majority opinion as a basis for finding "repudiation" by petitioners of findings they proved to be facts (see III R. 2066, 2071, 2073).

Scattered throughout the majority opinion are references to what Radtke or Whitson "contends" (*e. g.*, III R. 2065, 2067, 2071, 2072) which are cited in support of the Court's finding. These references in every instance are to assertions or contentions by counsel, which we submit to be in nowise binding on petitioners or of the slightest evidential weight against them. Such assertions (in each instance matters of technical fact or opinion) are not subject to cross examination nor to rebuttal evidence on the asserted propositions of fact or opinion, and there was no corresponding testimony. Of what significance is it as against petitioners, for example, that Radtke's counsel asserted Justice Adkins' was "misled" into making his Finding No. 15 (III R. 2072); the finding could be outweighed only by sufficient legal evidence to the contrary, and there was none.

And at III R. 2070-2072, the majority opinion misconstrues statements made in petitioners' application to the effect that appropriate amplifiers were known, as admissions of lack of novelty or invention in the circuit leading from the photoelectric cell to the amplifier. On this basis the parts of petitioners' claims having to do with the immediate photoelectric cell circuit in which flows a "correspondingly modulated current" were cast aside by the Court. The "acoustically modulated light" part of petitioners claims was also ignored in the face of Justice Adkins' undisputed finding (II R. 1638, fol. 2359) that even this part of the combination did not exist in any accurate and sufficient sense prior to petitioners.

By thus unjustifiedly eliminating the above parts of petitioners' claimed combination from consideration, the Court reduces its discussion to the question (as an isolated abstraction) of whether it required invention to deduce that a photoelectric cell might be usable for sound reproduction, and even as to this the Court ignores Justice Adkins' Finding No. 11 (II R. 1638) to the effect that there were no preexisting instruments by which its qualities for that purpose could be tested. The facts found by Justice Adkins (see No. 8, II R. 1637) as to the highly complex vibrations of widely different intensities and frequencies of which sound waves are composed, and the need of reproducing these accurately and faithfully before sound reproduction in any useful sense exists, the lack of any prior practical use whatsoever of the photoelectric cell (II R. 1636 No. 7), the fact that the photoelectric cell could not be used in circuits which had previously been proposed for the unsuccessful selenium cell (II R. 1639 No. 14), petitioners' pioneership throughout the world in successful sound-on-film reproduction (II R. 1635 No. 4), the radical differences in requirements and operating conditions between sound reproduction and other proposed uses of photoelectric cells (II R. 1642-1645 Nos. 21 to 31), are all ignored.

A large part of the majority opinion merely goes to show that there were such things as photoelectric cells prior to petitioners (III R. 2063-66) and that it was known how to make them, a fact which Justice Adkins himself noted (II R. 1636 No. 7). At II R. 2065 a statement on behalf of petitioners that people knew how to make photoelectric cells is emphasized in the majority opinion, and is followed by an entirely unwarranted deduction that others skilled in the art would "presumably" know all that petitioners' inventors knew.

In short, bearing in mind the above unwarranted and speculative inferences and deductions, and the utter lack of *evidence in the case* substantiating them, we submit the lack of legal foundation for the majority finding of unpatentability becomes plain.

POINT 4

Unsuccessful prior efforts by others are evidence of invention rather than the lack of it.

At III R. 2077 the majority states the fact that "numerous others for many years have been experimenting and writing toward that same objective, is suggestive in itself that what is here involved is not invention". But the fact findings of Justice Adkins showed that all prior attempts to accomplish that objective had been unsuccessful (II R. 1636 No. 6) and that petitioners were the first to succeed (II R. 1635 No. 4). There was no evidence here, as in the prior Tri-Ergon cases cited at III R. 2077, that the present combination relates to auxiliary or collateral matters not going to the heart of the problem, nor any explanation why others failed to take the steps which led petitioners to success. Under such circumstances the history of the art is evidence supporting invention and not in derogation thereof. (*Smith* v. *Snow*, 294 U. S. 1, 6; *The Barbed Wire Patent Case*, 143 U. S. 275, 283; *Eibel Process Co.* v. *Minnesota & Ontario Power Co.*, 261 U. S. 45.)

POINT 5

The subject matter is of general importance justifying review by this Court.

In the prior Altoona case (*supra*, p. 3) certiorari was granted by this Court in the absence of any divergence of judicial opinion upon the questions involved. As shown *supra*, page 3 the present subject matter is of equal importance, and accordingly is respectfully submitted to be equally entitled to review, under this Court's Rule 38, 5 (c).

POINT 6

The decision of the Court of Appeals if permitted to become final will unjustly relieve Radtke's already issued patent from the consequences of petitioners' adjudicated priority over Radtke, so that this defense against the Radtke patent could not later be presented to this Court or any other court in any other case.

The effect of the Court of Appeals' decision of course is to deny petitioners a patent upon their application, under circumstances where Radtke's conflicting patent has already been issued by the Commissioner (III R. 1798), and despite concurrence by the Court of Appeals in the District Court's finding that petitioners have established priority of invention over Radtke (III R. 2077).

Under the doctrine of *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, 13, 14, petitioners' priority thus found will not be available to anyone as a defense against the Radtke patent, unless a patent issues to petitioners.

If the Court of Appeals decision stands, Radtke will thus be left free to litigate his patent in other jurisdictions, and with petitioners' priority eliminated as a defense by the force of the same decision which holds that in view of petitioners' priority "Radtke invented nothing" (III R. 2077).

This we submit to be an unjust and anomalous situation, which can come before this Court in no later litigation. (See *Schriber-Schroth Company* v. *The Cleveland Trust Company,* 305 U. S. 47, 50, as supporting review by this Court under analogous circumstances.)

POINT 7

The Court of Appeals acted as the Guardian of the Radtke interests rather than those of the public.

As a basis for its excursion outside of the record on an investigation of patentability, the majority appellate opinion refers "to our capacity as the guardian of the public interest" (III R. 2059) as if the Court were thereby shielding the public from a patent monopoly. This is not the case in view of Radtke's already issued patent which is still left outstanding with the support of the final rulings of the Commissioner of Patents and two District Judges to the effect that the subject matter is patentable, with two appellate judges holding to the contrary and the third appellate judge holding that the ruling of the other two was unjustified.

As above pointed out, the action of the Court merely "guards" Radtke's interests, and those of his licensees (*supra,* p. 9), by eliminating as a defense to the Radtke patent, petitioners' priority which the District Court and the Court of Appeals concurred in holding to be established. We fail to see where the public interest is aided by the creation of such a situation, and similar conclusions have been reached by other Circuit Courts of Appeals (*Larson* v. *Crowther* [8 Cir.], 26 Fed. 2nd 780, 790; *Cutler Hammer Mfg. Co.* v. *General Electric Co.* [7 Cir.], 6 Fed. 2nd 376, referring at page 378 to too great sympathy for the rights of the "public" under similar circumstances).

POINT 8

The Court of Appeals has misapplied this Court's decision in Hill v. Wooster, 132 U. S. 693.

As the dissenting appellate opinion points out "a very different situation exists" (III R. 2079) in the present case, both because the Commissioner of Patents as a representative of the public has been at all times a party defendant herein and neither pled nor presented evidence on the points raised in the majority appellate finding; and for the further reason that in a previous suit against the Commissioner as the representative of the public interest, the patentability of the subject matter was adjudicated ten years ago, the decision was not appealed by the Commissioner and became final, and has not since been questioned by any of the tribunals until the majority appellate opinion saw fit to do so on the basis of the Court's own independent researches. Also, it appears that the decision in *Hill* v. *Wooster* was rendered on facts in the record, and upon simple subject matter which the Court could fairly pass upon without the aid of testimony of those skilled in the art on the points involved, and in contrast with the "intricate and technical" (III R. 2059) subject matter here involved, as to which we submit that it was not competent of members of the Court to undertake to serve as their own experts.

For all of the above reasons it is respectfully urged that the writ should be granted.

KENNETH S. NEAL,
PAGE S. HASELTON,
Counsel for Petitioners.

Dated, New York, September 25, 1941.

FILED
NOV 3 1941
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1941

No. 661

AMERICAN TRI-ERGON CORPORATION and TRI-ERGON HOLDING A. G.,

Petitioners (Plaintiffs),

v.

RADTKE PATENTS CORPORATION and ALBERT A. RADTKE, WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON, CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondents (Defendants).

MEMORANDUM FOR PETITIONERS IN REPLY TO BRIEF OF RESPONDENT—COMMISSIONER OF PATENTS

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225 Broadway,
New York City.

Dated: October 31, 1941.

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MEMORANDUM FOR PETITIONERS IN REPLY TO BRIEF OF RESPONDENT—COMMISSIONER OF PATENTS

1. The Commissioner's Statement of the "Questions Presented" is Inadequate.

We do not agree with the Commissioner's statement of the "Questions Presented" (his brief, pages 2, 6). The petition presents not the abstract question of whether an Appellate Court "may consider" the matter of invention in an action of this character, but the question of whether it is consistent with the requirements of a fair hearing, or consistent with accepted Federal Procedure, for an Appellate Court in so doing to formulate its own findings of lack of

invention on *de novo* grounds involving scientific treatises, many of which are not in evidence, and none of which are accompanied by the testimony of witnesses skilled in the art supporting the Court's conclusions, nor by findings of the District Court or the Patent Office in respect thereto, and as to which matters petitioners were never apprised by the pleadings or proofs, and therefore had no opportunity for cross examination or rebutting evidence.

We further differ decidedly with the assertion in the Commissioner's brief (p. 10) to the effect that an Appellate Court in a suit under usual Federal procedure and involving subject matter which the Court itself termed "intricate and technical" (III R. 2059) may "draw the inference of no invention * * * in the absence of supporting testimony of any expert witness". The brief correctly states that such an "inference may be drawn by the Patent Office" in conducting its administrative practice of ruling upon such matters without hearing any witnesses at all, upon the presumption that the various Examiners are skilled in their respective "arts". But an entirely different situation exists in the present suit, wherein decision is to be rendered according to the usual rules of Federal Procedure. On the basis of its own ruminations and without the support of witnesses skilled in the art, or findings on these treatises by either the District Court or the Patent Office, the Appellate Court has found *de novo* that one skilled in the art with knowledge of such treatises could have evolved the claimed combinations without the exercise of inventive talent. On such an issue—

> "the question of whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is one of fact" (*Thompson Spot Welding Co.* v. *Ford Motor Company,* 265 U. S. 445, 446).
>
> "So that it certainly was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result or, if material at all, were only such as would not require the exercise of the faculty of invention but would be suggested by the

skill of an experienced workman" (*Keyes* v. *Grant,* 118 U. S. 25, 36, 37).

The "course of equity * * * under the Federal system presupposes the finding of material facts by the trial Judge" (*Lorenz* v. *Colgate-Palmolive-Peet Co.* [3 Cir.] decided October 1, 1941, 51 U. S. Patents Quarterly 72, 77).

Accordingly we respectfully submit that the majority Appellate opinion below went beyond its proper province in going outside the Record to rule on *de novo* grounds affecting such factual questions which the Court itself characterized as "intricate and technical" (III R. 2059).

2. The Rule of Decision Emphasized in the Commissioner's Brief Applies Only to the Final Patent Office Rulings of Patentability, and not to Earlier Conflicting Rulings.

At page 11, the Commissioner's brief urges that the Court was "bound" to find "there was no invention as determined by the Patent Office in 1927." Although the Commissioner's brief (p. 9) concedes that the later Patent Office interference rulings would "ordinarily" be determinations "of patentability" superseding the 1927 rejection it is suggested that the present case should be treated on a different footing, on the ground that the Commissioner "considered himself bound by the 1931 decision" (Com'rs. brief, pp. 8, 9; the "1931 decision" being the District Court's decree by Justice Adkins that petitioners are entitled to a patent on their application).

But the Commissioner's rulings (through his Interference Tribunals) following Justice Adkins' decree show very plainly

(1) That the Patent Office did not consider itself bound thereby in the interference proceedings; and

(2) A reversal in the extremist sense of the initial Patent Office ruling against patentability.

In the interference the Patent Office held that even with a knowledge of petitioners' application disclosure additional "inventive features" would have to be used to enable one skilled in the art to practice the invention (III R. 1998, also I R. 30). This was the ground on which the Patent Office held petitioners' application disclosure insufficient, denied a patent to petitioners and issued a patent to Radtke instead (III R. 1798). This ruling was a far cry from being bound by Justice Adkins' decision, since as the District Court pointed out in the present suit (II R. 1517) Justice Adkins in rendering his decision necessarily found petitioners' disclosure application sufficient. Furthermore the above Patent Office interference decision in finding "inventive features" supplementary to petitioners' application disclosure would be necessary to practice the invention, is diametrically opposed to the initial Patent Office decision to the effect that the prior art renders the whole matter obvious and non-inventive. In so ruling the Patent Office went Justice Adkins one better on the subject of patentability.

This Patent Office interference decision—utterly inconsistent with a finding of lack of invention,—was the final ruling of the Patent Office with which petitioners and the Courts were confronted in the present suit, and we submit, the only ruling to which any legal presumption of correctness could be properly attached. How could such a presumption reasonably also embrace an earlier inconsistent ruling from which the Department itself had departed, and thus render both of two inconsistent departmental rulings presumptively correct?

In the present suit the Commissioner pled that the decision of his "Board of Appeals in said interference" was correct (I R. 19) and we submit that no presumption of correctness can be legitimately applied to earlier Patent Office rulings inconsistent therewith. The matter cannot be disposed of as the Commissioner's brief undertakes to do at page 11 by urging (contrary to the Patent Office in-

terference rulings and pleadings herein as above mentioned) that there is "ample support in the record" for the Appellate finding of lack of invention. If the majority of the Appellate Court had been satisfied to rest on evidence in the record, why would the large number of extraneous publications have been marshalled in support of their findings, particularly when their action in so doing was one of the grounds of the dissenting Appellate opinion (III R. 2079-80). *The majority findings were predicated on the sum total of these publications irrespective of whether within or without the Record, or earlier or later in date than petitioners.* There was no Appellate finding that any of them *disclosed* the claimed combinations, nor that the publications in the record are sufficient to show lack of invention, nor did the Patent Office or the District Court so find, and we submit that the above assertion now made in the Commissioner's brief is not a sufficient substitute for appropriate and timely pleadings and proofs affording opportunity for rebutting proofs by petitioners.

Accordingly we submit that the Commissioner's brief fails to advance sound reasons sustaining the action of the Appellate Court in going outside of the record to formulate *de novo* grounds for *de novo* findings of fact, and without according to petitioners a fair hearing on the disputable issues of technical fact thereby raised and determined by the Appellate Court on the basis of its own appraisal of these technical matters.

Respectfully submitted,

KENNETH S. NEAL,
PAGE S. HASELTON,
Counsel for Petitioners.

Dated: New York, N. Y., October 31, 1941.

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In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 661

AMERICAN TRI-ERGON CORPORATION AND TRI-ERGON HOLDING A. G., PETITIONERS

v.

RADTKE PATENTS CORPORATION AND ALBERT A. RADTKE, WHITSON PHOTOPHONE CORPORATION AND DELMAR A. WHITSON, CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR RESPONDENT COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The memorandum opinion of the District Court of the United States for the District of Columbia (R. 1510) is reported in 30 F. Supp. 83. The opinion of the United States Court of Appeals

for the District of Columbia (R. 2056–2080) is not yet officially reported.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered on June 30, 1941 (R. 2081). A motion for rehearing was denied on August 29, 1941 (R. 2094). The petition for writ of certiorari was filed on September 27, 1941. The jurisdiction of this Court is invoked under section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether, in a proceeding brought pursuant to R. S. 4915 to obtain the issuance of a patent, where the question of invention was neither framed by the pleadings nor put in issue before the district court, an appellate court may consider the question and, on the ground that the claims fail to describe a patentable invention, direct a dismissal of the complaint.

2. Whether the record supports the conclusion of the court below that, as determined by the Patent Office in 1927, the claims in suit are unpatentable because lacking in invention.

STATUTE INVOLVED

Revised Statutes, sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and

Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. 63):

> Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and con-

ditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The petitioners are the assignees of all rights to and under a patent application which was filed in the Patent Office on April 4, 1921, by Vogt and others. The application (R. 1557–1563) deals with a sound-reproducing apparatus whereby light is passed through a film on which sound has been recorded, causing acoustically modulated light to strike a photoelectric cell having an alkali cathode, setting up a correspondingly modulated current. In July 1927 the Board of Appeals of the Patent Office sustained a final rejection of the claims on the ground that no invention was involved (R. 1619–1622). Thereafter, American Tri-Ergon Corporation (hereinafter referred to as the petitioner) and others filed suit against the Commissioner of Patents under section 4915 of the Revised Statutes. The district court (Adkins, J.) held that the claims were patentable and entered a decree authorizing the Commissioner to issue the patent (R. 1625–1626). The Commissioner took

no appeal from the judgment, but in view of the holding that the subject matter was patentable, declared an interference among petitioner and the respondents Radtke and Whitson, who were applicants for patents on the same subject matter (R. 1626–1628). In the interference the Patent Office awarded priority to Radtke (R. 1963–1998), and on April 19, 1938, a patent was issued on his application (R. 1798).

Petitioners then filed the instant suit under R. S. 4915 to obtain a decree declaring that Vogt and others were the original inventors and authorizing and directing the Commissioner to issue a patent to petitioner (R. 2–16). The question of patentability was not drawn in issue by the pleadings and was not litigated. Finding no clear error in the decision of Justice Adkins (R. 1517), the district court (Goldsborough, J.) held that Vogt was entitled to priority over Radtke and Whitson and rendered a judgment authorizing the issuance of a patent to petitioner (R. 1526). In so doing it concluded that the claims define a "meritorious invention" (R. 1526), but apparently based that conclusion on the decision of Justice Adkins rather than on any independent determination of its own.

On appeal by Radtke and Whitson, the court below held that the question whether the claims disclosed invention must first be decided (R. 2058–2059). Concluding that in view of the prior art the claims lacked invention (R. 2077) and that

none of the parties was entitled to the monopoly desired (R. 2078), the court found it unnecessary to decide the question of priority (R. 2077–2078). It reversed the judgment of the district court and remanded the cause with instructions to dismiss the complaint (R. 2078). Justice Stephens dissented (R. 2078–2080).

ARGUMENT

The decision of Justice Adkins in 1931, while possibly *res judicata* as between the petitioner and the Commissioner of Patents, is not binding on the other respondents and the issue of patentability, therefore, may be determined in the present proceedings if properly raised. The petitioners do not contend otherwise. The questions involved are first, whether the court below had power to pass upon the question of patentability when the issue had not been framed by the pleadings of the parties or been litigated in the district court, and, second, whether the court below properly determined that the claims disclosed no invention. On both questions, we submit, the judgment below was correct.

1. As the court below held, the decision of this Court in *Hill* v. *Wooster,* 132 U. S. 693, controls as to the jurisdiction of an appellate court to pass upon the question of patentability on its own motion. In that case, which arose out of an interference proceeding involving two rival applicants

for patent on the same subject matter, both parties contended that invention existed, and they had apparently convinced the Commisisoner of Patents to that effect. At the trial no question as to invention was raised nor was evidence specifically introduced to show that there was invention. The trial court decided the case solely on the issue of priority. This Court, however, held that on appeal a court had not only the right but the duty to pass upon the question of invention before authorizing the issuance of a patent in a proceeding commenced under R. S. 4915. It found that the record before it disclosed lack of invention and directed the entry of a judgment in accordance with such conclusion. The facts in that case are strikingly similar to those here involved. Both cases arose out of an interference proceeding and the issue of patentability was not litigated.

Petitioners (Pet. 26) attempt to distinguish the decision in *Hill* v. *Wooster* on the ground that the Commissioner of Patents was not there a party, whereas he is a party in the instant suit and has not contested the patentability of the claims. They imply that the duty devolves upon him rather than upon the court to protect public interests against the grant of a monopoly where no true invention exists. That argument, however, overlooks the position of the Commissioner in the instant suit, and is, in any event, unsound. As the result of the decision of Justice Adkins in 1931,

the ruling of the Patent Office that the claims lacked invention was overruled. The Commissioner was not required to appeal from that judgment and his failure to do so no more relieved the courts of their duty to pass upon the question of patentability than did the failure of the Commissioner in *Hill* v. *Wooster* to find originally or to appear and urge later in the courts that the claims were unpatentable. There is nothing in the record to show that the Commissioner in the instant suit failed to contest the patentability of the claims for any reason other than that, as prior thereto in the interference proceeding, he considered himself bound by the 1931 decision. Accordingly, the wisdom of the rule requiring an appellate court to scrutinize the question of invention in a proceeding under R. S. 4915, even though such question is ignored by the parties, seems peculiarly evident in the instant case.[1]

2. The decision below on the question of patentability is correct and since it is not in conflict with that of any other court, except the district court, it presents no question for review. *Keller* v. *Adams-Campbell Co.,* 264 U. S. 314, 319–320; *Layne &c. Co.* v. *Western Well Works,* 261

[1] It may be noted that the court below was prompted to proceed as it did through the efforts of an amicus curiae (R. 2058). The applicants who were parties to the suit were interested in obtaining the patent for themselves and obviously were not seeking a holding that no invention was involved.

U. S. 387, 393; *General Pictures Co.* v. *Electric Co.,* 304 U. S. 175, 178–179. As the court below said (R. 2059), the determination of the Patent Office in 1927 that no invention was disclosed should be followed if "there is found to be a rational basis for the conclusions approved by the administrative body." *Mississippi Valley Barge Line Co.* v. *United States,* 292 U. S. 282, 286–287; *Rochester Tel. Corp.* v. *United States,* 307 U. S. 125, 146. The petitioners do not challenge, but apparently agree (Pet. 11, 19–20) that such is the proper scope of judicial review. The question whether the court below adopted the proper test to be applied upon review of a Patent Office determination is thus not presented.

Petitioners contend, however, that the court below was unjustified in not following the "final" rulings of the Patent Office and the findings of the district court in this case and in the 1931 proceedings (Pet. 19–21). The "final" rulings referred to are the declaration of an interference and an award of priority to Radtke. But, while ordinarily such a declaration involves a determination of patentability, in this case the interference was declared only after the 1931 judgment and in the view that the Patent Office was bound thereby. The district court in this case made no independent determinations of the facts on the issue of invention,[2] and, in-

[2] A remand to allow the district court to make such findings is not required under the rule of *Hill* v. *Wooster*, as is

sofar as the findings of Justice Adkins in 1931 called for application of the rule as to the scope of review of trial court findings, the court below correctly applied it (R. 2061–2078).

As the opinion of the court below fully discloses, there was ample evidence in the present record to support the finding of the Patent Office in 1927 (R. 1615–1622) that Vogt's disclosure of the use of a photoelectric cell in the reproduction of sound and as an efficient substitute for the selenium cell had been known to the art prior to Vogt's application (R. 2063, 2068, 2070). The petitioners' suggestion (Pet. 16–18) that the inference of no invention may not be drawn in the absence of supporting testimony of any expert witness is without substance. The inference may be drawn by the Patent Office and, in the absence of an administrative decision, by the court, as was done in *Hill* v. *Wooster, supra.* Manifestly, the court is not required to depend on the production of "expert" witnesses by applicants who are interested in sustaining patentability or by the Commisisoner who may not be a party.[3] Nor is it required to look solely to the testimony of those who are produced.

---

clear from the decision there. Moreover, since the record plainly discloses a rational basis for the 1927 decision of the Patent Office (see *infra*, p. 11), the district court would be required to find nonpatentability as a matter of law.

[3] The Commissioner is not a necessary party and may not be joined at all where, as in most cases, the action is instituted outside the District of Columbia. Cf. *Jax Ice & Cold*

Petitioners complain that the court below took judicial notice of evidence not in the record. Whether the court erred in so doing need not be considered. For it is clear that, even if such evidence had been disregarded, the court would have been bound by the record evidence to find that there was no invention as determined by the Patent Office in 1927.[4]

Storage Company v. *Coe*, 118 F. (2d) 12 (App. D. C.), certiorari denied, No. 823, October Term, 1940; *Eno Limited* v. *Coe*, 106 F. (2d) 858 (App. D. C.).

[4] Petitioners state (Pet., p. 6) that the following references, not a part of the record, were relied upon by the court below: (1) *Walker* and *Lance*, "Photoelectric Cell Applications" (2d ed. 1935); (2) *Allen*, "Photoelectricity" (1913); (3) *Hughes* and *DuBridge*, "Photoelectric Phenomena" (1932); (4) *Zworykin* and *Wilson*, "Photocells" (2d ed. 1934); (5) Henney, "Electron Tubes in Industry" (1934); and (6) *Millikan*, "A Direct Photoelectric Determination of Planck's 'h'", 7 Phys. Rev. 355 (1916). These references were used by the court to support its conclusion that photoelectric cells were well known prior to 1919 (R. 2063). The court, however, found ample support in the record for this conclusion. 14 Bureau of Standards Bulletin 507 (1918); Testimony of Enge (R. 2065); Testimony of Bullard, Vogt's witness; Testimony of Radtke's and Whitson's witnesses (R. 2066). The other references to which the petitioners except, namely the Langmuir patent, the World patent, and the Kuntz Article (Pet., p. 6) were cited to demonstrate that successful experiments had been made to amplify currents from a photoelectric cell (R. 2070). But to support this conclusion the court relied primarily upon the Bergwitz Article and the Bureau of Standards Bulletin (R. 2070), which were in the record, as well as upon the testimony of expert witnesses (R. 2071).

CONCLUSION

For the reasons above stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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Supreme Court of the United States

OCTOBER TERM, 1941

No. 740

WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON,

Petitioners,

vs.

CONWAY P. COE, Commissioner of Patents; AMERICAN TRI-ERGON CORPORATION, TRI-ERGON HOLDING A. G., RADTKE PATENTS CORPORATION and ALBERT A. RADTKE,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

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October Term, 1941, No.

Whitson Photophone Corporation and Delmar A. Whitson,
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Conway P. Coe, Commissioner of Patents; American Tri-Ergon Corporation, Tri-Ergon Holding A. G., Radtke Patents Corporation and Albert A. Radtke,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON, respectfully pray for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia to review the judgment of that Court in the above entitled cause. A transcript of the record therein, including the proceedings in said Court of Appeals has been furnished in accordance with the Rules of this Court, in connection with the Petition for Writ of Certiorari filed heretofore by American Tri-Ergon Corporation, et al.

STATEMENT OF CASE

1. Jurisdiction

This Court's jurisdiction is invoked under Section 240 (a) of the Judicial Code (28 U. S. C. A. 347). The date of the judgment, review of which is sought, is June 30, 1941, and the date of denial of rehearing is August 29, 1941.

2. Nature of Suit

This was an action under Revised Statutes 4915 (35 U. S. C. A. 63), filed by the American Tri-Ergon Corporation and Tri-Ergon Holding A. G., hereinafter designated as Vogt, against your petitioners herein, hereinafter designated as Whitson, and Radtke Patents Corporation and Albert A. Radtke, hereinafter designated as Radtke, and Conway P. Coe, Commissioner of Patents. Your petitioners, Whitson, filed an answer and counterclaim and the parties Radtke and Coe filed answers.

Each of the parties Vogt, Whitson, and Radtke alleged substantially in their respective complaints, answers and counterclaims that he was the first and original inventor of the apparatus for which Letters Patent were sought.

3. Subject Matter

The respective applications of the parties for grant of Letters Patent claimed invention of an apparatus to reproduce sound from a sound track or record photographically recorded on film. More specifically the applications of all parties claim the same four counts as set forth in the decision of the Court of Appeals (III R. 2057).

4. Prior Proceedings

Your petitioners Whitson were the first of the parties to file an application for a patent on the subject matter here

involved, on August 20, 1920; the party Vogt filed on April 4, 1921; and the party Radtke on December 27, 1922. Thereafter, from time to time, each of the parties, operating independently and without the knowledge of the others, engaged in controversies with the Patent examiners until in 1927 the Vogt application was rejected on the ground that it did not constitute invention over the prior art, that the prior art anticipated the subject matter (II R. 1619).

(*a*) *Justice Adkins' Decision*:

After such rejection the party Vogt prosecuted an action under R. S. 4915 in the Supreme Court of the District of Columbia in which the Commissioner of Patents was a party. The Commissioner contested the action on the ground that the subject matter of the application was anticipated by the prior art. After trial and after the introduction of evidence by experts and others, Justice Adkins rendered a decision and Findings and Conclusions, specifically holding the subject matter to be invention and therefore patentable. Judgment was rendered thereon authorizing the issuance of a patent to the party Vogt "upon compliance with the requirements of law in such cases made and provided." (II R. 1625).

It is important to note that in this proceeding before Justice Adkins, the People of the United States were represented by the Commissioner of Patents; that through him they took no appeal from said decision and judgment; and that, therefore, the People are bound by that finding and decree that the subject matter was patentable.

(*b*) *Interference Action*:

After the rendition of the judgment and decision by Justice Adkins the Commissioner of Patents declared an interference between the respective applications of the three applicants and directed that they put on their proofs on the

issue of priority. (II R. 1626). Thus, at the commencement of hostilities between the three applicants, their proofs and the issues were limited to priority.

In accordance with the direction of the Patent Office, the parties proceeded to take extensive and voluminous testimony from the Atlantic Sea coast to the Pacific, covering a period of several years, all relating to the issue of priority. On August 17, 1936, (III R. 1963) the Examiner of Interference awarded priority to Radtke which was subsequently affirmed by the Board of Appeals on March 17, 1937, (I R. 28-36) rehearing denied January 22, 1938, (I R. 38-40). The decision of the Examiner related to priority. Nothing was contained therein relating to patentability of the counts. Patent No. 2,114,939 was issued to Radtke as a result.

(*c*) *District Court decision below*:

Thereafter, the party Vogt commenced an action in the District Court for the District of Columbia under R. S. 4915, appealing from the judgments of the Patent Office and the Board of Appeals, in which action Radtke, Whitson and the Commissioner of Patents were named as defendants. Whitson counterclaimed against all of the other parties named therein. The three applicants each alleged (as hereinbefore stated) himself to be the first and original inventor of the subject matter. No issues were tendered or framed on any point but that of priority, the Commissioner contenting himself with seeking his dismissal as not being a proper or necessary party, which was denied to him.

After trial of some five weeks duration, together with the addition of a couple of thousand additional pages of testimony and several dozen more exhibits, to a record of elephantine proportions, Justice Goldsborough rendered his decision (II R. 1510-18), and decree was entered on November 20, 1939, (II R. 1526) based upon Findings and

Conclusions (II R. 1518-1525), authorizing the Commissioner of Patents to issue a patent to Vogt.

Once again it is important to note that this decision of Justice Goldsborough, together with his decree and Findings did not touch or concern patentability, but merely priority, as did the decision of the Examiner of Interferences.

(*d*) *Court of Appeals Decision*:

From this decision of Justice Goldsborough both Radtke and Whitson prosecuted appeals to the Court of Appeals of the District of Columbia. After having the case under submission for more than a year, the Court of Appeals, in an opinion written by Justice Miller and concurred in by Justice Rutledge, (III R. 2056) held that the subject matter did not constitute invention over the art as it existed prior to March 3, 1919, which latter date was the date upon which the party Vogt filed an application in Germany for a patent on the same subject matter, claimed to be the "convention date," and consequently that to none of the contestants were the counts patentable.

Justice Stephens, in a written opinion, dissented from this decision, stating (III R. 2078):

> "I think the decision in this appeal should be upon the question of the correctness of the decree below on the issue of priority and the ancillary issue of disclosure, and that the court should not pass upon the question of patentability."
>
> . . . "Not only was there no issue raised below by either Whitson, Radtke or Vogt as to patentability, but also the Commissioner of Patents made no contention against patentability."

The parties Vogt and Radtke have already filed their petitions herein for writs of certiorari to the said United States Courts of Appeals for the District of Columbia. Whitson by this petition prays for similar relief.

QUESTIONS PRESENTED

1. Was due process of law denied petitioners by a finding of lack of invention by the Court of Appeals of the District of Columbia predicated upon issues not presented in the pleadings and upon which petitioners were afforded no opportunity to produce evidence?

2. Did the Court of Appeals properly make a finding of lack of invention predicated upon scientific treatises later in date than the alleged date of conception and disclosure of petitioners, many of which are not in evidence?

3. Was a finding of lack of invention by the Court of Appeals of three justices, one dissenting, proper where it is contrary to the findings of two Justices of the District Court within the same circuit?

4. Was the Court of Appeals justified in divesting itself of its duties as a reviewing court to protect the public interest where the public is represented by a duly constituted officer, appointed for that purpose?

5. Was the Court of Appeals justified in protecting the public interest where that protection has become moot by reason of the grant of a patent which cannot be recalled?

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

1. In finding the subject matter unpatentable by consideration of scientific treatises and technical documents, some not in evidence and some published later than petitioners' date of conception and disclosure, without the aid of expert testimony or findings of the trial court supporting such finding, the Court of Appeals has so departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of super-

vision. (Rule 38, 5(b); dissenting opinion III R. 2080; Helis v. Ward, 308 U. S. 365, 370).

2. The Court of Appeals has denied to petitioners their day in Court by deciding matters of scientific fact and opinion which were not presented in the Trial Court and on which petitioners had no opportunity to introduce evidence or to cross examine. (Helis v. Ward, 308 U. S. 365, 370).

3. The Court of Appeals has decided a Federal question in a way probably in conflict with decisions of this Court. (Rule 38; Hill v. Wooster, 132 U. S. 693).

4. The Court of Appeals in a divided opinion reversed a decision by making a finding contrary to the decisions of two District Justices within the District, thus creating a situation where three Justices within the District have held to the contrary. (Robertson & Kirkham, Jurisdiction of the Supreme Court of the United States, p. 618, paragraph 306.) (Morgan v. Daniels, 153 U. S. 120, 125; Mississippi Valley Barge Line Co. v. United States, 292 U. S. 282, 286, 287; Adamson v. Gilliland, 242 U. S. 350, 353; Rule of Civil Procedure, No. 52(a); this Court's Rule 38, 5(b), (c).)

5. The United States Court of Appeals has decided a question of general importance which should be reviewed by this Court. (Rule 38, 5(c); Altoona Publix Theatre Inc. v. American Tri-Ergon Corp., 294 U. S. 477.)

6. The Court of Appeals erroneously applied this Court's decision in Hill v. Wooster, 132 U. S. 693 in considering the question of lack of invention which neither the Commissioner of Patents nor the parties sought to prove and in the face of the patent issued to Radtke.

JOSEPH A. SHAY,
KIMBALL FLETCHER, JR.,
Counsel for Petitioners.

Dated, Los Angeles, October 29, 1941.

Supreme Court of the United States

OCTOBER TERM, 1941, No.

WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON,
Petitioners,

vs.

CONWAY P. COE, Commissioner of Patents; AMERICAN TRI-ERGON CORPORATION, TRI-ERGON HOLDING A. G., RADTKE PATENTS CORPORATION and ALBERT A. RADTKE,
Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I. Opinion of the Court Below

The opinion of the District Court is reported in 30 Fed. Supp. 83. The opinion of the Court of Appeals of the District of Columbia has not as yet been officially reported but is contained in III R. 2056.

II. Grounds of Jurisdiction and Statement of Case

These matters are believed to be sufficiently set forth in the foregoing petition.

III. Assignment of Errors

Petitioners urge that the United States Court of Appeals of the District of Columbia erred:

1. In finding the subject matter involved here to lack invention and thus to be unpatentable upon a consideration of matters and issues outside of the pleadings and proofs and as to which petitioners have had no fair opportunity to be heard.

2. In finding lack of invention in the technical subject here involved upon a consideration of scientific treatises (some of which are not in evidence and some of which were published after petitioners' date of conception and disclosure) without the aid and benefit of expert testimony, opinion and consideration of such treatises, and without findings of the trial court or Commissioner of Patents in support thereof.

3. In attempting to protect the public interest where such interest is adequately represented by the Commissioner of Patents and where such protection is moot by virtue of the grant of the monopoly of an issued patent.

4. In treating statements made by the parties during the course of the prior proceedings with respect to amplifiers and their circuits as admissions of lack of invention in petitioners' immediate photoelectric cell circuit.

5. In failing to construe and interpret the prior art as of petitioners' date of conception and disclosure and in construing such art as of a much later date.

6. In adopting rulings and findings of the Commissioner of Patents which had been reversed by later final decisions of such Commissioner and by decisions of the District Court.

7. In finding that experiments and writings by others which never achieved success to be evidence of lack of invention.

8. In failing to find that petitioners were the first and original inventors of the subject matter involved herein and in failing to direct the District Court to enter a decree

in favor of petitioners authorizing the Commissioner of Patents to grant a patent to petitioners and in failing to reverse the decree finding that petitioners lacked priority.

IV. Argument

POINT 1

The issue of lack of invention was not before the court and petitoners had no fair hearing thereon

As is quite apparent from a perusal of the record herein, the scientific matters therein discussed are of quite a technical nature and the testimony of the experts is very lengthy. Supplementing such testimony numerous scientific treatises and publications, as well as many other issued patents, have been introduced into evidence. Despite all this the Court of Appeals departed from the record to decide the entire case upon an issue never raised in this action—an issue finally decided some ten years ago by the Supreme Court of the District of Columbia in the so-called Adkins' decision (Supra, p. 4; II R. 1646-50)—decided contrary to the majority decision below.

As is pointed out (supra, p. 4), upon the entry of the Justice Adkins' decision, the Commissioner of Patents declared the interference and directed proofs as to priority. From this date, January 7, 1932, to the present time, the issue of lack of invention has never arisen in this case—has never been presented in the pleadings of the parties, in the testimony of witnesses, in the documents introduced into evidence, or in the briefs of any of the parties hereto. No testimony was introduced on this point, therefore no cross examination thereon was had. No testimony was introduced, therefore no notice was conveyed to petitioners to go to their proofs on this point.

The issue of lack of invention has been presented only prior to the Adkins' decision, in the inter-office proceed-

ings of the Patent Office and in the District Court before Justice Adkins, and finally and completely decided by him, and in the brief of *amicus curiae* before the Court of Appeals.

Petitioners have been denied their day in Court and, therefore, come within the rule of Helis v. Ward, 308 U. S. 365 at 370:

> "For review by this Court was sought and granted on the ground that the Circuit Court of Appeals had decided the merits on facts not contained in the record and on a theory which had never been tried by the litigants."

As pointed out in Walker on Patents, Deller's Ed., Vol. 3, p. 2025, ". . . It is generally necessary for a defendant to introduce expert testimony on that point (invention) for a question of invention is a question of fact."

The question of invention being one of fact, we have in the present case a situation in which the Court of Appeals has made a finding without any evidence on the fact being before it. The issue is one which is open to much dispute and should not be the subject of judicial notice and, to quote the dissenting opinion below, the appellate court should not

> "reach an answer to such a question upon the basis of its own examination of data not in the record, . . . without first affording opportunity to the parties to be heard in respect to it and an opportunity to supply additional relevant data." (III R. 2080).

We submit that your petitioners have been denied their day in court and should be accorded an opportunity to present their proofs respecting lack of invention.

POINT 2

The Court of Appeals was not justified in attempting to protect the public interest

Adopting the rule and decision in Hill v. Wooster, 132 U. S. 693, the Court of Appeals stated:

> "In our capacity as guardian of the public interest, . . . we must consider the question (invention)." (III R. 2059).

We submit that the court misconstrued and misapplied the decision of that case. In Hill v. Wooster, supra, an interference action had been declared and, after decision by the Commissioner of Patents, an action was commenced under R. S. 4915. The Commissioner was not a party to that action and the question of invention was not presented by the two litigants. In that case there was no prior finding of invention by the District Court. It was held in that case that, in the interests of the public, the court should consider the question of invention. It is apparent that Hill v. Wooster and the present action are dealing with two different horses. Here we have a decision (prior to the declaration of interference) by the District Court that the subject matter is invention and is patentable. We have a finding of patentability by the Commissioner of Patents in the interference action based upon such decision. We have a finding by Justice Goldsborough in the lower court of "neither the error or the evidence" (III R. 2058) that there was error in the Adkins' decision or additional evidence which would have produced a different result in the Adkins' decision. And in addition the Commissioner of Patents *is* a party to the present action.

The Commissioner of Patents is the officer charged with the protection of the public interests in the matter of granting the exclusive monopoly conferred by Letters Patent.

In his pleadings in this action he alleged the correctness of the final decisions by the Commissioner. He did not seek to overcome the monopoly granted by the patent issued, by alleging a lack of invention. That point had already been determined by Justice Adkins and that determination has long been final. The Commissioner could have appealed from Justice Adkins' decree, but he did not. He, representing the People of the United States, accepted that decision. In seeking to protect the public interest the Court of Appeals has stepped from its position as a reviewing court into the position of the Commissioner of Patents as the guardian of the public interests in patent monopolies. It has usurped the function of an administrative officer which it has no power to do. But, even assuming the power, if it has usurped that function, and therefore represents the People, then it is subject to whatever limitations the People are subject. The People, being bound by the actions of the Commissioner of Patents, the representatives of the People are likewise bound—the Court, usurping that power, representing the People, is bound by the People's acquiescense in that decision.

But even more, the question of patentability, so far as the present litigation is concerned, has become moot—the monopoly has been granted by the patent issued to Radtke. The majority decision protects, not the People of the United States, not the public interest, but the party Radtke and his interest. The majority decision bars Whitson and Vogt from asserting their rights to a patent, and leaves Radtke with his patent. With this patent Radtke may go to another district and enforce rights protected by the patent. (McNeeley v. Williams, 96 Fed. 978.) The question of patentability may be raised in another district and a different conclusion reached. (Lowell v. Triplett, 77 Fed. (2) 556; affirmed in 297 U. S. 638; rehearing denied 298 U. S. 691.) But, to no other district may Whitson or Vogt go to secure

patents—Radtke has a patent—Radtke, the one party to this action who, by his own testimony, is not entitled to a patent because of wilful suppression and concealment (II R. 1057). To no other district may Whitson or Vogt go to enforce their rights for, without a patent, they have no rights.

We submit that the Court of Appeals did not protect the interests of the public in rendering its decision.

POINT 3

The Court of Appeals should have construed and interpreted the prior art as of January 24, 1915, rather than March 3, 1919.

The Court of Appeals stated in its decision (III R. 2058):

> "However, the first and most important question which was presented for decision to the District Court, which was presented on this appeal by *amicus curiae*, and which we must now decide, is whether the four claims in issue do define an invention, patentable as of March 3, 1919."

This date of March 3, 1919, as stated heretofore, was the date upon which the party Vogt filed his application in Germany for a patent on the subject matter involved here. It has always been contended by the party Vogt that, under the Convention rule, he is entitled to rely upon this date as his filing date, even though his United States filing was later in date. The Court of Appeals arbitrarily adopted this date as the earliest date to which any of the parties was entitled, without making any finding upon the conflicting issues and contentions respecting said early dates.

It is the contention and allegation of Whitson that he conceived his invention prior to January 24, 1915, and that

on said date he disclosed his ideas and conceptions to others. It is not the date of filing an application for a patent which is controlling, but the date of conception.

> "While the first and original inventor, generally speaking, is *prima facie* the one who first reduces an invention to practice, i. e., reduces his invention to a fixed, positive and practical form, the one who first conceives an invention and proceeds to perfect it and adapt it with reasonable diligence, *may date back his invention to the date of conception* and succeed as to priority over a second inventor who has, in fact, first perfected and actually reduced his invention to practice in a positive form." (Emphasis ours.) Walker on Patents (Deller's Ed. 1937, p. 378).
>
> ". . . Under our patent system, he who first arrives at a complete conception of the inventive thought is entitled to recognition and reward. . . . " Laas v. Scott, 161 Fed. 122.

If, then, he who first arrives at a "complete conception of the inventive thought" is entitled to a patent, as a necessary corollary to that rule, that conception must be of an invention.

> "In determining whether patentable invention is involved, it is proper to take into consideration the condition of the trade or art to which the patent is applied. Other factors to be considered are those which show the character, condition and progress of the art to which the invention relates; the nature of the want supplied; and the extent to which previous inventions had satisfied the want. So also, proof of prior unsuccessful efforts of others to accomplish the results obtained, may resolve a doubt in favor of invention." (Citing cases.) Walker on Patents (Deller's Ed. 1937, p. 119.) And again on page 120:
>
> "It may also be shown that the invention in question is more efficient than the method or device pre-

viously used for the same or analogous purposes, or more economical, or has other advantages over known methods or devices."

It has always been the contention of Whitson that he antedated most of the prior art references used throughout this extensive litigation; that at the time of his conception no one taught, in patents, publications, or otherwise, the use of the photo-electric cell for the reproduction of sound. It is an accepted fact that photoelectric cells had been used for quite some time prior to 1915 for photometric purposes (measuring the quantity of light) by astronomers and by others. The properties of photoelectric cells had long been known. It was known that the "lag" or "fatigue" of selenium cells was not present in photoelectric cells. But, no references, whether put in evidence by the parties hereto, or not in evidence but cited by the Court of Appeals, shows or teaches the use of photoelectric cells for reproduction of sound.

It has long been Whitson's contention that he invented, not a circuit, but a means of reproducing sound. Radtke makes great "to do" over his "resistance"—Vogt uses undamped high frequency—but Whitson uses a simple circuit (Radtke's circuit without the resistance) and it works, as evidenced by Tasker's testimony (Radtke's expert) during the trial below (II R. 1195). Whitson contends, not that he invented a circuit, not that he has to use a particular circuit, but merely that he invented a method of reproducing sound by means of a photoelectric cell; that he conceived this invention as of January 24, 1915, as evidenced by Whitson Interference Exhibit No. 10. Therefore, whether Whitson did or did not invent anything must be decided

from a study of the art as it existed at the time he claims invention—not as of a later date.

No reason has been assigned by the Court of Appeals for its failure to consider invention as of Whitson's date of Conception and disclosure. If the Court, as it did, considered authorities arising between January 24, 1915, and March 3, 1919, and concluded that they anticipated the invention as of March 3, 1919, it does not follow that the same invention as of 1915 would fall in the same category.

We submit that Whitson has again been denied his day in Court by a failure to construe the prior art as of the date of Whitson's disclosure, January 24, 1915.

POINT 4

The Court of Appeals incorrectly construed the prior art on its merits.

The majority decision of the Court of Appeals proceeds at great length to arrive at the conclusion that the use of a photoelectric cell to reproduce sound was an obvious substitution for the selenium cell which any mechanic in the art could have made. However, a much simpler device was held to be invention in The Barbed Wire Patent Case, 143 U. S. 275, where this Court said:

> "It may be strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to *substitute* a coiled wire in place of the diamond shape prong, but evidently it did not; *and to the man to whom it did ought not to be denied the quality of inventor.*" (Emphasis ours.)

In Loom Co. v. Higgins, 105 U. S. 580, at 591 this Court stated some very pertinent language:

> "It may have been under their very eyes, they may almost be said to have stumbled over it; but they cer-

tainly failed to see it, to estimate its value, and to bring it into notice. . . . *Now that it has succeeded, it may seem very plain to any one that he could have done it as well.* This is often the case with inventions of the greatest merit." (Emphasis ours.)

And in George Frost Co. v. Cohn, 112 Fed. 1009, it was held that the substitution of a rubber button for a metallic button on a garter was invention, even though the properties of rubber had long been known and used for just such things.

The only prior art reference cited as of a date prior to Whitson's date of conception and disclosure, January 24, 1915, is the article by Bergwitz in Physikalische Zeitschrift (1907) 378, Radtke Suit Exhibit "FF," (III R. 1945) in which the author states:

> "Undoubtedly on basis of the experiments related here, it will be possible to transmit telephone signals at some distance in the same way as with the selenium cell." (English translation III R. 1951.)

Immediately we reread the article to ascertain how he proposes to do this. Not only do we find that the author does not tell us how, but we note the language that he proposes to transmit signals, not reproduce sound. This cannot be said to be anticipation.

> "Prophetical suggestions and surmises in prior patents or publications, of what results can be achieved in a particular art, are not enough to negative the novelty of any patent on an invention which can accomplish that result."
>
> Westinghouse Air-Brake Co. v. Great Northern Ry., 88 Fed. 258, C. C. A. 2 (1898);
>
> Asbestos Shingle, etc., Co. v. H. W. Johns-Manville Co., 184 Fed. 620, C. C., S. D. N. Y. (1910).
>
> "But when such a patent merely *prophesies* what can be done without setting forth that it has been done,

> or makes claims for things not fairly disclosed in the specifications, the foreign patent does not anticipate." Becket v. Coe., 98 Fed. (2) 332, App. D. C. (1938).

Under these authorities, should it be said that Bergwitz conceived the subject matter here in issue? Can it be said that Bergwitz' article amounted to more than wishful thinking? Yet the Court of Appeals has cited this article as anticipation—cited the article to show that those skilled in the art could produce the subject matter here involved. Yet, to digress beyond the record on our own part, in the early 1920s patents were still being sought and granted for reproduction of sound using *selenium* cells, even though it was well known that these cells had a lag and fatigue which rendered them unfit for sound frequencies. Yet men in the art were still trying to make them work. Can it be then said that men skilled in the art could take the prior teachings and use photoelectric cells to reproduce sound from acoustically modulated light?

The Court of Appeals has proceeded, in the majority decision, upon a false premise as evidenced by its language at III R. 2077:

> "We are satisfied that, individually and collectively, they (the parties hereto) have successfully challenged every contention and disproved every claim."

The Court has misconstrued the evidence. Testimony on the part of Whitson has been introduced to show that at the time of filing his application (August 20, 1920) men skilled in the art knew how to connect an amplifier or Audion tube in a circuit with a photoelectric cell in order to amplify the feeble currents of such cell. The introduction of this testimony was rendered necessary by a smoke screen created by our opponents, namely, that Whitson's application did not disclose an operable invention because it did not show the circuit connections to the various elements of

the Audion tube and also because his battery designations did not show potentials or polarities. Whitson also introduced testimony to show that men skilled in the art would know how to connect batteries and to determine the correct potential by "cut and try" methods. To show how foolish some of these adverse contentions were, Whitson Interference Exhibit No. 338, the United States Patent Office Chart for Draftsmen, sheet 2, symbol No. 62 does not require that any polarity be shown. From the fact that Whitson contends that photoelectric cells were so well known that men skilled in the art knew how to connect them, and from the testimony to that effect, the Court concluded that they were so well known that it was not invention to use them for sound reproduction.

We submit that the prior art has been improperly construed and applied by the Court of Appeals.

POINT 5

The subject matter is of general importance justifying review by this Court

In Altoona Publix Theatres Inc. v. American Tri-Ergon, 294 U. S. 477, the subject matter there involved concerned the same field as that involved here and the latter is of equal importance with that there involved.

CONCLUSION

The United States Court of Appeals for the District of Columbia has rendered a decision which is novel, erroneous, of public importance and seriously prejudicial to your petitioners.

WHEREFORE, petitioners pray that their petition for writ of certiorari be granted and the cause be reviewed

and the petitioners granted such relief as may be found just and proper.

Respectfully submitted,

JOSEPH A. SHAY,
KIMBALL FLETCHER, JR.,
Counsel for Petitioners.

Dated, Los Angeles, October 29, 1941.

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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1941

No. 705

RADTKE PATENTS CORPORATION and
ALBERT A. RADTKE,

Petitioners,

against

CONWAY P. COE, Commissioner of Patents,
AMERICAN TRI-ERGON CORPORATION,
TRI-ERGON HOLDING A. G.,
WHITSON PHOTOPHONE CORPORATION and
DELMAN A. WHITSON,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF

LEONARD DAY,
Counsel for Petitioners.

October 6, 1941.

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IN THE

Supreme Court of the United States

October Term, 1941

No. .....

RADTKE PATENTS CORPORATION and
ALBERT A. RADTKE,
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CONWAY P. COE, Commissioner of Patents,
AMERICAN TRI-ERGON CORPORATION,
TRI-ERGON HOLDING A. G.,
WHITSON PHOTOPHONE CORPORATION and
DELMAR A. WHITSON,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Radtke Patents Corporation and Albert A. Radtke respectfully pray for a writ of certiorari

to the United States Court of Appeals for the District of Columbia to review a judgment of that Court entered on June 30, 1941 (III R. 2081), rehearing denied August 29, 1941 (III R. 2094). A transcript of the record in the case, including the proceedings in said Court, we are informed has been furnished in accordance with the Rules of this Court.

A. Summary and Short Statement of the Matter Involved

The present suit is in equity, brought by American Tri-Ergon Corporation and Tri-Ergon Holding A. G. under United States Revised Statutes, Section 4915 (35 U. S. C. A. Section 63). Joined as defendants were Albert A. Radtke, Radtke Patents Corporation, Delmar A. Whitson, Whitson Photophone Corporation and Conway P. Coe, the Commissioner of Patents. The parties and their several interests are hereinafter set forth. Delmar A. Whitson and Whitson Photophone Corporation in their answer interposed a counterclaim seeking similar relief under Section 4915. The history of the litigation in short is as follows:

On March 3, 1919 Hans Vogt, Josef Engl and Joseph Massolle filed in Germany a German application for Letters Patent. On April 4, 1921 Vogt, Engl and Massolle filed an application for Letters Patent of the United States. The American Tri-Ergon Corporation and Tri-Ergon Holding A. G. are the assignees of Vogt et al. For convenience the application and the parties in interest will be referred to hereafter as "Vogt".

The four claims in controversy were made in the Vogt application in 1925. The Examiner found that the claims were unpatentable (II R. 1611) and the Board of Appeals affirmed (II R. 1619). Vogt thereafter filed a Section 4915 suit. After trial before Judge Adkins, a decree was

entered dated December 17, 1931 (II R. 1625—*American Tri-Ergon Corp* v. *Robertson,* 11 U. S. Pat. Q. 168) in which it was adjudged that these claims defined a patentable invention and authorized the Commissioner of Patents to issue Letters Patent thereon to Vogt.

By amendment, Whitson sought in his application for patent claims identical with the four claims in the Vogt application, which he copied in 1929 from the Vogt application. Whitson Photophone Corporation is the assignee of Delmar Whitson and both for convenience will be referred to hereafter as "Whitson".

Radtke from the time of filing his application in 1922 sought in his application claims similar in scope and then amended to include the same four claims held patentable by the Court. Radtke Patents Corporation is the assignee of Albert A. Radtke and both for convenience will be referred to hereafter as "Radtke".

In January, 1932 and after Judge ADKINS' decision the Commissioner of Patents instituted an interference proceeding between Vogt, Radtke and Whitson. Proofs were taken by all three parties. On July 18, 1936 the Examiner of Interferences awarded priority of invention to Radtke (III R. 1963). On March 17, 1937 the Board of Appeals affirmed the award of the Examiner (II R. 28). On January 22, 1938 the Board of Appeals, by its decision following a rehearing, reaffirmed its decision of March 17, 1937 (II R. 38). On April 19, 1938 a patent was issued to Radtke (U. S. Letters Patent 2,114,939).

The present suit was filed on May 13, 1938 by Vogt. On November 20, 1939 the District Court filed its decree (*American Tri-Ergon Corp.* v. *Coe,* D. C., 30 F. Supp. 83) awarding priority to Vogt and authorizing and ordering the Commissioner of Patents to issue Letters Patent embodying the four claims to American Tri-Ergon Corporation. An appeal was thereafter taken by Radtke and

Whitson to the United States Court of Appeals for the District of Columbia. On June 30, 1941 said Court of Appeals rendered its opinion holding all four counts unpatentable on publications not anticipating Radtke's proven date of invention, reversing the decree of the District Court and remanding the same with instructions to dismiss the complaint, Judge STEPHENS dissenting (III R. 2056). Petition for rehearing by Whitson was denied on August 29, 1941.

The party Vogt has already filed its petition herein for a writ of certiorari to the said United States Court of Appeals for the District of Columbia. Radtke makes this petition for similar relief.

Questions Presented

The substantial questions presented here are:

1. Whether the Court of Appeals should not have passed upon the questions of the incorrectness of the decree of the District Court below and the correctness of the rulings of the Patent Office tribunals on the issue of priority and the ancillary issues of disclosure and reduction to practice, rather than on the question of patentability.

2. Whether the Court below properly could consider and rely upon as established fact highly debatable scientific references on the question of patentability, which were neither in the record nor referred to in the briefs and which none of the parties had opportunity either to discuss or to meet with expert testimony and which the evidence shows are not prior to the date of invention by the party Radtke.

The Majority Opinion of the Court of Appeals Below

The United States Court of Appeals for the District of Columbia, upon suggestion of *amicus curiae* first presented on appeal, undertook to decide whether the four claims in issue did define an invention patentable as of March 3, 1919 (a date long after Radtke's 1916 date).

Accordingly, it inquired into the correctness of the rulings of Mr. Justice ADKINS in the original 4915 suit brought by American Tri-Ergon against Robertson, then Commissioner, wherein Mr. Justice ADKINS had held that the four claims did define patentable invention.

The Court undertook to examine this question in its capacity as "guardian of the public interest", relying upon the case of *Hill* v. *Wooster*, 132 U. S. 693, 698. As is pointed out in the dissenting opinion of the Court below, it is submitted that the case at bar is distinguishable.

The Court ignored the question of the incorrectness of the decree of the District Court below and the correctness of the rulings of the Patent Office tribunals on the issue of priority and the ancillary issues of disclosure and reduction to practice. It merely contented itself with the statement, "We may assume hypothetically, that either the Patent Office or the District Court correctly decided the question of priority, as between such disclosures as may have been made by each of the parties" (III R. 2077-2078). Upon the pleadings the only issues before the trial Court were that of priority of invention and the further ancillary issue as to whether Vogt's application disclosed what was defined in the claims in suit. The parties directed themselves mainly to the question of priority of invention and the ancillary questions thereto.

The majority of the Court of Appeals relied upon highly debatable scientific references on this question of

patentability which were neither in the record nor referred to in the briefs. We submit that Mr. Justice STEPHENS was correct when he stated in his dissenting opinion that the Court cannot take judicial notice of disputed facts. Your petitioners further agree with Judge STEPHENS' statement that "an appeal court cannot properly reach an answer to such a question upon the basis of its own examination of data not in the record, and which may be disputable, without first affording opportunity to the parties to be heard in respect of it and an opportunity to supply additional relevant data." It is to be noted that the majority of the Court of Appeals relied upon publications some of which were published as late as the 1930's and relied upon statements made therein as anticipatory. In the proofs Radtke sought the date of late 1916 for his date of conception. The Patent Office Examiner, on the evidence, granted priority of invention to Radtke, holding that Radtke had conceived in March, 1917 and reduced to practice in September, 1919. The Board of Appeals held it unnecessary exactly to determine Radtke's conception date prior to 1919 and gave him the dates September and November of 1919 for his reduction to practice. The Court below, in relying upon these publications of the 1930's, took the highly debatable statements therein contained of what were or were not facts as of the dates which each of the parties sought to obtain and which Radtke did obtain. Your petitioners submit that these publications speak as of the 1930's. It is easy with afterthought to attribute lack of invention to the pioneer who has taught us. Perhaps the majority of the Court did not realize that they were speaking of the 1930's and not of the date which Radtke claimed.

The invention, upon which Radtke has been granted a patent, is admittedly a highly important one, has gone

into wide commercial use and is in common use in sound picture apparatus. Many licenses have been taken by the industry under the Radtke patent. The question of patentability in such a case is debatable and should not have been, in all fairness to Radtke, decided for the first time on appeal without first affording the parties an opportunity to adduce testimony thereon.

The decision of the Court of Appeals, if correct, would ignore the rights of parties to be confronted with and have the opportunity to meet all questions raised on appeal for the first time. It would deprive a party of the right to be heard. It would permit a Court to rely upon statements made in questionable texts covering highly scientific problems as fact rather than as disputable and debatable matter. It would further ignore the interests and rights of an inventor and the public to have judicially determined the questions of *originality* and *priority*.

The Minority Opinion of the Court Below

The minority opinion of Mr. Justice STEPHENS is so well and tersely stated that no further statements need be made.

B. Reasons Relied Upon for the Allowance of the Writ

The discretionary power of this Court is invoked upon the following grounds:

1. The United States Court of Appeals for the District of Columbia has decided novel and important questions of Federal law in a manner which is believed to be untenable and in direct conflict with the applicable decisions of this Court.

2. The United States Court of Appeals for the District of Columbia has decided important questions of Federal law the effect of which is of great public importance and interest.

WHEREFORE your petitioners respectfully pray the allowance of a writ of certiorari to the United States Court of Appeals for the District of Columbia and submit their brief in support of this petition.

Respectfully submitted

LEONARD DAY,
Counsel for Petitioners.

Dated, October 6, 1941.

IN THE

Supreme Court of the United States

October Term, 1941

No. .....

RADTKE PATENTS CORPORATION and ALBERT A. RADTKE,
Petitioners,

against

CONWAY P. COE, Commissioner of Patents,
AMERICAN TRI-ERGON CORPORATION,
TRI-ERGON HOLDING A. G.,
WHITSON PHOTOPHONE CORPORATION and
DELMAR A. WHITSON,
Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The Opinions of the Courts Below

The opinion of the District Court is reported at 30 Fed. Supp. 83. The opinion of the United States Court of Appeals is set forth in the record, III R. 2056.

Jurisdiction

The grounds of jurisdiction are:

1. The date of the judgment to be reviewed is June 30, 1941 (III R. 2081), rehearing denied August 29, 1941 (III R. 2094).

2. The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code (28 U. S. C. A. 347).

Statement of the Case

The facts are sufficiently stated in the petition.

Specification of Errors

The errors which petitioners will urge, if the writ of certiorari is allowed, are that the United States Court of Appeals for the District of Columbia erred:

1. In considering and relying upon as established fact highly debatable scientific references on the question of patentability, which were neither in the record nor referred to in the briefs and which none of the parties had opportunity either to discuss or to meet with expert testimony.

2. In ignoring the question of the correctness of the decisions of the Patent Office tribunals and the incorrectness of the decision of the trial Court on the issue of priority of invention and the ancillary issues of disclosure and reduction to practice.

Argument

POINT I

Petitioners were not afforded opportunity to be heard in respect of the scientific references not in the record.

The record shows that the majority of the Court of Appeals relied upon highly debatable and questionable scientific references on the question of patentability which were neither in the record nor referred to in the briefs. It is apparent that the majority took judicial notice of these questionable references. It relied upon references some of which were published as late as the 1930's and upon statements made therein as anticipatory. It ignored the date of invention which had been accorded by the Patent Office tribunals to the petitioners. Based upon its own examination of these references, it reached the conclusion that the subject matter of the counts in suit was unpatentable.

The petitioners have had no opportunity to refute the conclusory statements made in these highly scientific references in any tribunal. They were presented to the petitioners for the first time through the means of the majority opinion of the Court below. If these conclusions and so-called findings had been presented earlier, your petitioners would have been put on notice and would have presented expert testimony as to each and every point raised thereby. That opportunity has been denied them. We submit that your petitioners have thus been denied their day in Court and their right to be heard thereon. The dissenting opinion in the Court below properly states:

> "an appellate court cannot properly reach an answer to such a question upon the basis of its own examination of data not in the record, and which may be dis-

putable, without first affording opportunity to the parties to be heard in respect of it and an opportunity to supply additional relevant data" (III R. 2080).

It is well settled that invention is a question of fact, and where a question arises whether the differences between the subject claimed in a patent in suit and the prior art amount to invention, it is necessary to introduce expert testimony as to that point. (*Walker on Patents,* Deller's Edition, Vol. 3, p. 2025.)

In

Sundh Elec. Co. v. *General Elec. Co.* (2nd Circuit), 204 Fed. 277, 279,

the Court held that highly technical matters, such as are here involved,

"* * * are matters in which a court must perforce depend upon the assertions of someone who has made a profound study of the matter".

See:

U. S. v. *Abilene & So. Ry. Co.,* 265 U. S. 274, 288.

In

Helis v. *Ward,* 308 U. S. 365, 370, 84 Law Ed. 327, 329,

certiorari was sought and granted on the ground that the Court of Appeals "had decided the merits on facts not contained in the record * * *."

POINT II

The decisions of the Patent Office tribunals awarding priority to Radtke should have been affirmed.

Upon the pleadings the only issue before the trial Court was that of priority of invention as among the three parties. In addition, it had before it the ancillary issues of disclosure and reduction to practice. The Court below wholly ignored these issues. It merely contented itself with the statement:

> "We may assume, hypothetically, that either the Patent Office or the District Court correctly decided the question of priority, as between such disclosures as may have been made by each of the parties" (III R. 2077, 2078).

The Patent Office is an administrative body of law experienced in dealing with applications for photoelectric patents, to whose well informed judgment and recognized discretion Congress has committed the determination of questions of fact on the basis of which the grant of Letters Patent is authorized. Its determination should be conclusive unless arbitrary, capricious or unsupported by substantial evidence.

The record discloses that in three separate and exhaustive decisions the Patent Office tribunals awarded priority of invention to Radtke upon that issue and the said ancillary issues. This award was based upon the fact of patentable invention.

The Court below ignored the rule firmly laid down by this Court in

Morgan v. *Daniels,* 153 U. S. 120;

wherein it stated:

> "Upon principle and authority therefor, it must be laid down as a rule that where the question decided

> in the Patent Office is one between contesting parties as to priority of invention, the decision there must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

No new evidence was adduced in the trial Court and the Patent Office findings should have been accepted as conclusive.

In

Swayne & Hoyt v. *U. S.*, 100 U. S. 297, 304,

referring particularly to determinations of the Shipping Board, this Court stated:

> "Such determinations will not be set aside by courts if there is evidence to support them. Even though, upon a consideration of the evidence, a court might reach a different conclusion, it is not authorized to substitute its own for the administrative judgment." (Citing cases.)

POINT III

The questions presented here are novel and of public importance.

The questions involved are obviously important because they affect not only the present parties but also all others who may now or hereafter be in similar situations. They affect the Federal Courts and litigants therein and it is of substantial importance to the public to ascertain whether the decision of the Court of Appeals is correct.

The subject matter here involved is highly important. The fact is that the improvement involved has gone into

wide commercial use in the motion picture industry. Many licenses have been taken under the Radtke patent. It is of equal importance to the subject matter involved in *Altoona Publix Theatres Inc.* v. *American Tri-Ergon,* 294 U. S. 477.

Conclusion

The United States Court of Appeals for the District of Columbia has rendered a decision which is novel, erroneous, of public importance and seriously prejudicial to petitioners.

WHEREFORE, petitioners earnestly pray that their petition for writ of certiorari be granted and the cause be reviewed and the petitioners granted such relief as may be found just and proper.

Respectfully submitted,

LEONARD DAY,
Counsel for Petitioners.

Dated, October 6, 1941.

In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 705

RADTKE PATENTS CORPORATION AND ALBERT A. RADTKE, PETITIONERS

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, AMERICAN TRI-ERGON CORPORATION, TRI-ERGON HOLDING A. G., WHITSON PHOTOPHONE CORPORATION, AND DELMAN A. WHITSON

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

MEMORANDUM FOR RESPONDENT COMMISSIONER OF PATENTS IN OPPOSITION

The present petition for a writ of certiorari seeks a review of the judgment of the United States Court of Appeals for the District of Columbia entered on June 30, 1941 (R. 2081), rehearing denied August 29, 1941 (R. 2094). A review of the same judgment is sought by the pending petition for a writ of certiorari in *American Tri-Ergon Corporation and Tri-Ergon Holding A. G.* v. *Radtke Patents Corporation, et al.*, No. 661, this Term. The petition in that case raises substantially the same questions as are presented by the instant petition. For the reasons stated in the brief for respondent Commissioner of Patents in opposition in No. 661, it is respectfully submitted that the instant petition should be denied.

CHARLES FAHY,
Solicitor General.

NOVEMBER 1941.

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